

REMARKS

Applicants thank the Examiner for the courtesies extended to the undersigned during the telephone interview. As discussed during the interview, Applicants submit this After Final response as requested by the Examiner and Applicants also submit an Interview Summary herewith.

Claims 1-4, 6-20, and 28-40 are pending in the present application.

Claims 1-4, 6-20, and 28-40 stand rejected under 35 USC 103(a) for obviousness over Internet Appliances (IA) (individual references labeled "X" and "UU" by the Office) in view of U.S. Patent No. 6,405,178 to Manchala et al.

Applicants respectfully traverse the rejection and urge allowance of the present application.

Regarding the 103 rejection, Applicants respectfully submit the Office has failed to establish a prima facie rejection of claim 1. There is no motivation provided by the Office to combine the teachings of reference "X" with the teachings of reference "UU" and accordingly the Office has failed to establish a prima facie rejection for at least this reason. Applicants request withdrawal of the 103 rejection for this reason alone.

In addition, Applicants submit that the 103 rejection of claim 1 is improper for the reasons set forth in Applicants' last response inasmuch as there is no motivation to combine the teachings of Manchala with the teachings of UU and X. The Office provides a motivational rationale on page 6 in support of the 103 rejection as "in order to be proactive in printer servicing." Applicants respectfully submit the motivation is not properly supported by the objective evidence of record and does not satisfy the authority of *In re Lee* provided in the previous responses regarding proper motivation to combine or modify prior art references.

For example, as recognized by the Office on page 5 of the Action, IA *already teaches* internet appliances becoming proactive using embedded web server technology. There is no evidence of record that one would be motivated to look for additional teachings in Manchala regarding being proactive in view of the already proactive teachings of IA. Further, the Action on page 5 states that the incorporation of email into a Xerox color laser printer to send email to an administrator when the printer requires or soon will require service provides a proactive system. Accordingly, *references IA already disclose a "proactive" arrangement and there is absolutely no evidence of record that modification of the teachings of IA per Manchala would result in*

S/N: 09/976,642
PDNO. 10007583-1
Amendment D

any benefits compared with the unmodified references IA. Applicants respectfully submit the Office has failed to meet their burden of establishing proper motivation for the 103 combination and the 103 rejection is improper for at least this reason.

The Office on page 3 makes statements in support of motivation to combine the teachings of Manchala including alleging that one should be curious about what Zerox has to offer and alleges that Manchala provides teachings that one would seek to fill in gaps without identification of any objective evidence of record. The alleged motivation on page 3 of the Action is not supported by objective evidence and fails to comply with *In re Lee*.

Applicants also respectfully submit that even if the references are combined, the combination fails to disclose or suggest positively recited limitations of claim 1 and the Office has failed to establish a proper *prima facie* 103 rejection for this additional reason.

Claim 1 recites second determining when a predetermined work threshold has been reached and second transmitting an email to request *periodic service* in response to the second determining. On page 5 of the Action, the Office states IA teaches sending urgent email to request periodic maintenance referring to the teachings of page 2 of reference UU. Applicants have reviewed page 2 of reference UU relied upon by the Office and have failed to locate any teachings of the second transmitting the email to request periodic service as recited in claim 1. In addition, page 2 of reference UU merely states that *more complex internet appliances* require periodic and often instant maintenance. The teachings of UU regarding "*complex*" *internet appliances* needing periodic maintenance are void of any teachings of a hard copy output engine as defined in claim 1. Perhaps even more compelling, the bald cursory statement that complex internet appliances require periodic maintenance provides *no teachings as to how the maintenance is provided or performed* let alone that e-mail is used to request periodic service as claimed. In no fair interpretation can such bald, cursory teachings of reference UU be considered to disclose or suggest the positively recited limitations of determining by a *processor within a hard copy output engine when a predetermined work threshold has been reached or transmitting an email to request periodic service in response to the determining*.

In addition, Applicants have failed to uncover any teachings in Manchala with respect to transmission of an email to request periodic service in response to the

S/N: 09/976,642
PDNO. 10007583-1
Amendment D

claimed determining when a predetermined work threshold has been reached. Accordingly, even if the reference teachings are combined, the combination fails to disclose or suggest positively-recited limitations of claim 1 and claim 1 is allowable for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 36 recites the second determining comprises determining when the predetermined work threshold comprising a predetermined number of sheets printed by the hard copy engine has been reached. Applicants have failed to uncover any teachings in the prior art of these limitations and the Office has failed to identify any prior art teachings which allegedly disclose the limitations of claim 36. Limitations of claim 36 are not disclosed nor suggested by the prior art and claim 36 is allowable for at least this reason.

Claim 37 recites the second determining comprises determining when the predetermined work threshold comprising a predetermined length of time has been reached. Applicants have failed to uncover any teachings in the prior art of these limitations and the Office has failed to identify any prior art teachings which allegedly disclose the limitations of claim 37. Limitations of claim 37 are not disclosed nor suggested by the prior art and claim 37 is allowable for at least this reason.

Applicants have failed to uncover in the Office Action any identification of reference teachings which allegedly disclose or suggest the above-identified limitations of claims 36-37. In the event that a rejection of claims 36-37 is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicants respectfully request clarification of the rejections with respect

S/N: 09/976,642
PDNO. 10007583-1
Amendment D

to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final Action* if claims 36-37 are not found to be allowable.

Referring to independent claim 8, Applicants respectfully submit there is no motivation to combine the teachings of reference X with the teachings of reference UU and Applicants respectfully submit the Office has failed to establish a proper 103 rejection for at least this reason. In addition, Applicants respectfully submit there is no motivation to combine the teachings of Manchala with the teachings of references UU and X and Applicants respectfully submit the Office has failed to establish a proper 103 rejection for at least these reasons.

In addition, positively recited limitations of the claims are not disclosed by the prior art even if the references are combined. More specifically, the mere observation that more complex appliances may require periodic service fails to provide any teachings with respect to how periodic servicing is carried out let alone the specific limitations of claim 8. The teachings of the prior art even if combined fail to disclose or suggest the positively-recited limitations of claim 8 reciting *transmitting an email to request periodic service*. Further, the teachings of the prior art taken alone or in combination fail to disclose or suggest *requesting of periodic service in response to a predetermined work threshold being reached*. Positively-recited limitations of claim 8 are not disclosed nor suggested by the prior art and claim 8 is allowable for at least this reason.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 15, Applicants respectfully submit there is no motivation to combine the teachings of X with the teachings of UU and Applicants respectfully submit the Office has failed to establish a proper 103 rejection for at least this reason. In addition, Applicants respectfully submit there is no motivation to combine the teachings of Manchala with the teachings of references UU and X and Applicants respectfully submit the Office has failed to establish a proper 103 rejection for at least these reasons.

In addition, positively defined limitations of claim 15 are not disclosed nor suggested by the prior art if the teachings of the references are combined. More

S/N: 09/976,642
PDNO. 10007583-1
Amendment D

specifically, the system of claim 15 recites processing circuitry configured to transmit an email to a personal computer associated with the peripheral device for *retransmission from the personal computer to a vendor web site across a firewall*. The teachings of UU of the RomMailer relied upon by the Office on pages 3-4 of the Action to send email to an administrator when the printer requires service fails to teach the claimed transmission of the email *for ordering supplies*. Further, even if Manchala discloses communicating with an authorization service and a purchasing service as set forth on pages 4 and 6 of the Action, the Office has failed to identify any teachings of the specifically claimed transmission of the email for retransmission as positively claimed. The Office has failed to identify any teachings that the purchasing service placing an order with a vendor discloses the defined retransmission of the email. Accordingly, even if the reference teachings are combined, the combination fails to disclose or suggest positively-recited limitations of claim 15 and claim 15 is allowable for at least this reason.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 40 recites *the peripheral device and personal computer are within a side of the firewall opposite to a side of the vendor*. The Office has failed to identify any teachings of the relationship of a peripheral, computer and vendor with respect to a firewall as positively claimed. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final Action* if claim 40 is not found to be allowable.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

S/N: 09/976,642
PDNO. 10007583-1
Amendment D


13

Respectfully submitted,

Robert E. Haines

Mark A. Harper

By:


James D. Shaurette
Reg. No. 39,833
Date: 4/27/06

S/N: 09/976,642
PDNO. 10007583-1
Amendment D